



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,526	07/27/2000	Evan D.H. Green	NFC1P004X1	1198

7590 04/28/2004  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
12400 WILSHIRE BOULEVARD  
7TH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

JACKSON, CORNELIUS H

ART UNIT PAPER NUMBER

2828

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/626,526

Applicant(s)

GREEN ET AL.

Examiner

Cornelius H. Jackson

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 88,89,91,92,97-99 and 101-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 88,89,91,92,97-99 and 101-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Acknowledgement***

1. Acknowledgement is made that applicant's Amendments, filed on 19 May 2003, has been entered. Upon entrance of amendment, claims 88, 97, 101 and 116 were amended. Claims 88, 89, 91, 92, 97-99 and 101-125 are pending in this application.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 88, 89, 91, 92, 97-99 and 101-125 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda et al. (4947398). Yasuda et al. disclose a tunable filter

Art Unit: 2828

apparatus **Fig. 4**, comprising a grid generator **4** positioned in an optical path and configured to generate a first transmission peaks corresponding to channels of a selected wavelength grid; and a channel selector **5** positioned in the optical path and configured to generate a second plurality of transmission peaks, wherein the second plurality of transmission peaks have one more or one fewer peaks than the first plurality of transmission peaks within said wavelength range, **see Figs. 3a-c and 5, col. 4, lines 10-60 and col. 10, line 45-col. 12, lines 34.**

Regarding claims 89, Yasuda disclose the stated limitation, **see col. 2, line 40-col. 4, line 60.**

Regarding claims 91, 92 and 101, Yasuda disclose all the stated limitation, **see Fig. 4 and col. 9, lines 43-col. 13, line 20.**

Regarding claims 102-105, Yasuda disclose all the stated limitations, **see Fig. 4, col. 2, line 40-col. 4, line 60, col. 9, lines 43-col. 13, line 20 and col. 10, line 45-col. 12, lines 34.**

Regarding claims 106, Yasuda teach the grid generator and the channel selector comprise a Fabry-Perot filter/an interference element, **see abstract, col. 9, lines 43-col. 13, line 20.**

Regarding claim 107-109, 111, 112, 113 and 115, Yasuda disclose all the stated limitations, **see col. 4, line 48-col. 11, line 40 and col. 18, line 23-col. 19, line 11.**

Regarding claims 97-99 and 116-125, the method of a device is not germane to the issue of patentability of the device itself, since the device itself obviously uses the

Art Unit: 2828

method. Therefore the rejection used on the device applies also to the method of the device.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 110 and 114 rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (4947398). Yasuda et al., as applied to claims 88,89, 91, 92, 97-99, 101-109, 111-113 and 115-125 above, teach all the stated limitations except for the type of etalon used being gas spaced or a grating.

Regarding claims 110 and 114, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

7. Applicant's arguments filed 03 November 2003 have been fully considered but they are not persuasive.

Applicant argued Yasuda fails to teach, as presently amended, "wherein the second plurality of transmission peaks have one more or one fewer peaks than the first plurality of transmission peaks within said wavelength range". In response, a specific wavelength range is not given/recited in the claim limitations; therefore, any range may be use. Upon considering Figs 2a and 2b of Yasuda, when one looks at a range equivalent to the free spectral range of the coarse tuning etalon (from peak to peak), only three peaks of the fine tuning etalon appears. Also, it is noted that the features upon which applicant relies (i.e., a plurality of transmission peaks within the wavelength range of the laser) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that upon adding such limitation would make the claims readable on US. Patents 6,600,760 and/or 6,526,071 and therefore would be considered as double patenting.

### ***Conclusion***

8. Note that claims 88, 89, 91, 92, 97-99 and 101-125 of this application conflict with claims 1-28 and 33-36 of Application No. 10/087728 and claims 1-17, 19-34 and 36-54 of Application No. 10/099649. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Also see Zorabedian et al. (6282215).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

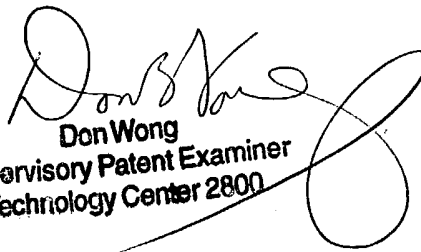
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (571)272-1942. The examiner can normally be reached on 8:00 - 5:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571)272-1834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2828

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chj

  
Don Wong  
Supervisory Patent Examiner  
Technology Center 2800